



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/541,256

04/17/2006

Fung-Lung Chung

11015-008

4893

29847 7590 04/14/2009
Beusse Wolter Sanks Mora & Maire
390 N. ORANGE AVENUE
SUITE 2500
ORLANDO, FL 32801

EXAMINER

STONE, CHRISTOPHER R

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

04/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,256	Applicant(s) CHUNG ET AL.	
	Examiner CHRISTOPHER R. STONE	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2009 has been entered.

Applicants' arguments, filed February 2, 2009, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Rejections Maintained

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6, 9 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by Hecht et al (Carcinogenesis, 23(9), p. 1455-1416, 2002).

Claims 1-6, 9 and 12 are drawn to a method of inhibiting lung tumorigenesis in a mammal in need thereof, comprising administering to said mammal an effective amount of a conjugate of an isothiocyanate at the post-initiation stages of tumor growth. Post-initiation stage is defined in the specification as any time period after exposure to a carcinogen. Hecht et al discloses a method of inhibiting lung tumorigenesis (malignant tumor growth) in a mouse, comprising the oral administration of an isothiocyanate conjugate (PEITC-NAC) at the post-initiation stages of tumor growth (p. 1456, column 2, paragraph 2; Fig. 2; Table II, groups 5,11 and 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 8, 10, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hecht et al.

In addition to the aforementioned teachings, Hecht et al discloses that lung cancer is the most common cancer in the world and the leading cause of cancer death in the United States. Smokers and ex-smokers are disclosed as high-risk for the development of lung cancer. Furthermore, Hecht et al teaches that there are no chemopreventative agents with proven efficacy in humans and that the goal of their research is to identify and develop such agents. Therefore it would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the method of Hecht et al to inhibit tumorigenesis in human smokers and ex-smokers, since lung cancer is so prevalent in this patient population, thus resulting in the practice of the instantly claimed invention with a reasonable expectation of success. It would have been prima facie obvious to one of ordinary skill in the art at the time of the instantly claimed invention to accomplish the oral administration using a tablet or capsule dosage form. Tablets and capsules are commonly used oral dosage forms in the pharmaceutical formulation art. The optimization of the dosage amount and schedule would have been obvious to one of ordinary skill in the art at the time of the invention to determine the regimen with maximum efficacy. This routine experimentation is common in the pharmaceutical art.

Rejections Newly Applied

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6, 9 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by Yang et al (Cancer Research, Vol. 62, p. 2-7, January 1, 2002, provided by Applicant).

Claims 1-6, 9 and 12 are drawn to a method of inhibiting lung tumorigenesis in a mammal in need thereof, comprising administering to said mammal an effective amount of a conjugate of an isothiocyanate at the post-initiation stages of tumor growth. Post-initiation stage is defined in the specification as any time period after exposure to a carcinogen. Hecht et al discloses a method of inhibiting lung tumorigenesis (malignant tumor growth) in a mouse, comprising the oral administration of an isothiocyanate conjugate (PEITC-NAC) at the post-initiation stages of tumor growth (abstract, p. 3, left column, paragraphs 1 and 2).

Response to Arguments

Applicant alleges that the submission of Yang et al (cited above) shows the conception of the claimed invention by the Applicant prior to the publication of Hecht et al (cited above). Conception alone is insufficient to antedate a reference applied under 35 USC 102(a). Applicants are directed to 37 CFR 1.131 indicating conception must be coupled with a showing of due diligence and constructive or actual reduction to practice. This is also found unpersuasive because the Yang et al publication has a different

Art Unit: 1614

inventive entity than the instant application and the publication is therefore also available as prior art under 35 U.S.C. 102(a). Applicant is direct to MPEP 715 and 716.10 and 2132 which discusses proper antedating a reference applied using a declaration under 37 CFR 1.131 and attributing a reference or part of a reference to the Applicant using a declaration under 37 CFR 1.132, respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. STONE whose telephone number is (571)270-3494. The examiner can normally be reached on Monday-Thursday, 7:30am-4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

01April2009

/Patricia A. Duffy/
Primary Examiner, Art Unit 1645